

REMARKS

Applicant has carefully considered the Office Action of November 2, 2005 and offers the following remarks in response thereto.

Claims 1-50 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over co-pending application no. 09/736,692. As neither application has matured into a patent, it is premature to address this provisional rejection. When one of the applications matures into a patent, Applicant will address the issue at that time.

Claims 1-47 and 50 were rejected under 35 U.S.C. § 103 as being unpatentable over Denecheau et al. (hereinafter "Denecheau") in view of Applicant's Admitted Prior Art (hereinafter "APA"), further in view of Nessett et al. (hereinafter "Nessett"). Applicant respectfully traverses. For the Patent Office to combine references in an obviousness rejection, the Patent Office must do two things. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with actual evidence. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). If a combination renders one of the references unsuitable for its intended purpose, then the combination is non-obvious. MPEP § 2143.01. Once a proper combination is made, to establish *prima facie* obviousness, the Patent Office must show where each and every element of the claims is taught or suggested. MPEP § 2143.03. If the Patent Office cannot establish obviousness, the claims are allowable.

Applicant initially traverses the motivation to combine the references. Specifically, the Patent Office asserts that the motivation to combine Denecheau with the APA is "because it makes use of sophisticated application-level knowledge." (Office Action of November 2, 2005, page 4, lines 11-12). This asserted motivation lacks the evidence required by the Federal Circuit. That is, the Patent Office has not proven that there is any desire to use sophisticated application-level knowledge in a system like Denecheau's system, nor has the Patent Office proven that the combination would actually allow use of the sophisticated application-level knowledge. To this extent, the motivation advanced by the Patent Office is not sufficient to combine the references. Since the combination is improper, the rejection is improper, and the claims are allowable. Applicant requests withdrawal of the § 103 rejection of the claims on this basis.

Applicant further traverses the combination of references because the combination renders Denecheau unsuitable for its intended purpose. Applicant notes that Denecheau still does not teach any application level processing in the node. While the Patent Office has stated

that Denecheau teaches the elements of the claim at col. 3, lines 43-58 and col. 6, line 66-col. 7, line 20, these passages discuss next hop routing based on destination, not based on the provision of application level processing. The inclusion of application level processing actually renders Denecheau unsuitable for its intended purpose because routing to provide such application level processing may contradict the next hop identified by Denecheau's method. As noted above, making a reference unsuitable for its intended purpose is evidence of non-obviousness. MPEP § 2143.01. Thus, the combination that the Patent Office is proposing is not obvious, and the claims are allowable.

Even if the combination is proper, a point which Applicant does not concede, the Patent Office has not established obviousness. Specifically, as noted by the Patent Office, Denecheau and the APA do not teach the compute plane in the routing node. The Patent Office relies on Nessett for this missing element. However, as noted by the Patent Office, Nessett uses an intermediate device to apply compression and/or encryption. There is no teaching that the decompression and compression resources 112, 113 of Nessett are within a compute plane as recited in the claims. The Patent Office asserts that it would be obvious to include a compute plane with functions such as compression and decompression as part of a routing node (see Office Action of November 2, 2005, page 4, lines 19-21) per the claims, but there is no explanation for why the decompression and compression resources 112, 113 of Nessett would be moved to a compute plane per the claims. Rather, the Patent Office merely says that the decompression functions are known and it would be obvious to put them on a compute plane. Establishing *prima facie* obviousness requires more than such broad conclusory statements. There must be some teaching that the application level functions are provided on a compute plane. To date, the combination does not teach or suggest this arrangement, and the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established obviousness, the claims are allowable.

For these reasons, Applicant requests withdrawal of the § 103 rejection of claims 1-47 and 50.

Claims 48 and 49 were rejected under 35 U.S.C. § 103 as being unpatentable over Denecheau, the APA, and Nessett further in view of Chiu et al. (hereinafter "Chiu"). Applicant respectfully traverses. The standards for establishing obviousness are set forth above.

Applicant initially notes that the Patent Office has stated that Denechcau, McCanne, and Kilkki teach the method of claim 1. The Patent Office has withdrawn this rejection and reference to it is inappropriate at this time.

Applicant traverses the rejection because, as noted above, the combination of Denechcau, the APA, and Nessett is improper and does not teach all the elements of the independent claims. The addition of Chiu does not cure these problems. Thus, claims 48 and 49 are allowable.

Applicant still further traverses the rejection because the Patent Office has not properly supported the motivation to combine the references. Specifically, the Patent Office asserts the motivation to combine the references is "because it would allow for more ways to route the traffic which would provide more efficient routing overall." (Office Action of November 2, 2005, page 13, lines 4-5). This asserted motivation lacks the required evidence. Since the motivation lacks the required evidence, the motivation is improper. Since the motivation is improper, the combination is improper. Since the combination is improper, the rejection is improper, and the claims are allowable for this reason as well.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The Patent Office has not properly combined the references, and even if the references are properly combined, the combination does not teach the application level processing on the compute plane as recited in the claims. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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